REMARKS

Claims 1-20 are pending in this application.

Claims 1-20 have been rejected.

No claims have been allowed.

No claims have been amended.

Claims 1-20 remain in the application. A copy of the claims is provided below in the Appendix for the convenience of the Examiner.

Reconsideration of Claims 1-20 is respectfully requested.

35 U.S.C. § 103(a) Obviousness

The Office Action rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,411,306 to Miller et al. ("*Miller*") in view of U.S. Patent No. 5,933,130 to Wagner ("*Wagner*"). This rejection is respectfully traversed.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re*

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

The Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness against the claims.

Regarding Claim 1, the Office Action acknowledges that *Miller* fails to disclose "indicator means for presenting a level indicator which is indicative of said adjustments" as recited in Claim 1. (*Office Action, Page 3, Paragraph 1*). The Office Action then asserts that *Wagner* discloses this

element of Claim 1 and that it would be obvious to modify *Miller* with the teachings of *Wagner*. (*Office Action, Page 3, Paragraphs 2-4*).

Wagner recites a graphical user interface that allows a user to manually set a "general brightness level" of images to be displayed using a sliding bar. (*Figure 7; Col. 9, Lines 6-16*). A display then adjusts the brightness level of images being presented to the user based on the general brightness level. (*Col. 8, Lines 27-43*). For example, the display may vary the brightness level of the images within a range centered at the user's general brightness level. (*Col. 8, Lines 27-43*). The user's specified brightness level could also represent a maximum or minimum brightness level to be used. (*Col. 8, Lines 44-58*).

Wagner never mentions that the sliding bar is used to indicate how the brightness level of an image has been altered or adjusted. For example, *Wagner* never mentions varying the brightness level of an image and then presenting the sliding bar to the user. Instead, *Wagner* simply mentions that the sliding bar allows a user to set the brightness level, and the brightness level is then used to present images to the user. The sliding bar therefore only represents the user's desired brightness level for images to be displayed.

In contrast, Claim 1 recites parameter control means adapted to cause adjustments to parameters of a signal and "indicator means" for "presenting a level indicator which is indicative of [the] adjustments." *Wagner* lacks any mention of an indicator identifying "adjustments" that have been made to a signal. As a result, *Wagner* fails to disclose, teach, or suggest "indicator means" for presenting a level indicator "which is indicative of [the] adjustments."

For these reasons, the proposed *Miller-Wagner* combination fails to disclose, teach, or suggest the Applicant's invention as recited in Claim 1 (and its dependent claims). For similar reasons, the proposed *Miller-Wagner* combination fails to disclose, teach, or suggest the Applicant's invention as recited in Claim 5 (and its dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection and full allowance of Claims 1-20.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

No fees are believed to be necessary. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: June 30, 2003

William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@davismunck.com*